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PATENT

ATTY. DOCKET #N1205-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Herbert M. WILSON, et al.
Serial No.: 09/140,886
Filed: August 26, 1998
Group Art Unit: 1649
Examiner O. Zaghmout
For: TRANSGENIC PLANTS

RESPONSE

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action dated June 7, 1999, please see remarks as follows:

REMARKS

The Examiner has rejected claims 1 and 15 under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant submits that native regulatory element or elements already present in the donor DNA are sufficient and other heterologous promoters or regulator elements are not necessary. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-22 are rejected under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicant submits that the specification provides adequate information to enable a person of ordinary skill in the art to make and/or use the invention. The native regulatory element(s) already present

in the donor DNA are sufficient and other heterologous promoters or regulatory elements are not needed. Accordingly, withdrawal of this rejection is respectfully.

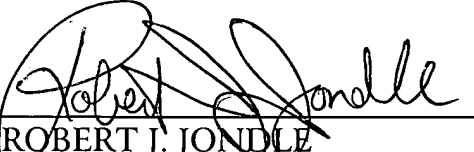
102 Claims 1-2, 8-9 are rejected under 35 U.S.C. §102(b) as being anticipated by Masoud et al. Applicant submits Masoud et al. introduces a cDNA (oryzacystatin-I) from rice which is linked to a heterologous promoter (35S) and the Nos 3' end into tobacco. The donor cDNA is characterized as a cysteine proteinase inhibitor based on its nucleotide sequence prior to transformation. The expression of the cDNA is controlled by heterologous regulatory elements such as the 35S promoter and Nos 3' end. Use of the present invention requires no characterization of the donor DNA (such as its sequence). Furthermore, no heterologous promoters or regulatory elements would be used, instead the native regulatory elements already present with the donor DNA would suffice. Accordingly, withdrawal of this rejection is respectfully requested.

103 Claims 1-22 are rejected under 35 U.S.C. §103 as being unpatentable over Masoud et al. in view of Hamilton et al. Applicant submits Masoud et al. (1993) introduces a cDNA from rice which is linked to a heterologous promoter (35S) and the Nos 3' end into tobacco. The donor cDNA is characterized as a cysteine proteinase inhibitor based on its nucleotide sequence prior to transformation. The expression of the cDNA is controlled by heterologous regulatory elements such as the 35S promoter and Nos 3' end. Use of the present invention requires no characterization of the donor DNA (such as its sequence). Furthermore, no heterologous promoters or regulatory elements would be used, instead the native regulatory elements already present with the donor DNA would suffice. The intent of Hamilton et al. is to characterize the donor DNA. The present invention does not involve a method of characterization prior to or after transformation. Accordingly, withdrawal of this rejection is respectfully requested.

In view of the above amendments and remarks, it is submitted that the claims satisfy the provisions of 35 U.S.C. §102, §103 and §112 and are not obvious over the

prior art. Reconsideration of this application and early notice of allowance is respectfully requested.

Respectfully submitted



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